

Application Serial No.: 09/828,341  
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### REMARKS

This is a full and timely response to the outstanding final Office Action mailed December 16, 2005. Claims 1-35 remain pending in the present application. Reconsideration and allowance of the application and pending claims are respectfully requested.

#### 1. Response To Rejections of Claims Under 35 U.S.C. §103

Claims 1-5, 10-21, and 26-35 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Moscato* (U.S. Patent No. 6,335,978) in view of *Manchala* (U.S. Patent No. 6,088,119). Claim 6-9 and 22-25 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Moscato* in view of *Manchala* in further view of *Schwenk* (U.S. Patent No. 6,590,995). It is well-established at law that, for a proper rejection of a claim under 35 U.S.C. §103 as being obvious based upon a combination of references, the cited combination of references must disclose, teach, or suggest, either implicitly or explicitly, all elements/features/steps of the claim at issue. See, e.g., *In Re Dow Chemical*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988), and *In re Keller*, 208 U.S.P.Q.2d 871, 881 (C.C.P.A. 1981). Applicants respectfully traverse the rejections.

##### a. Claim 1

As provided in independent claim 1, Applicants claim:

A system for verifying a document comprising:  
first means for providing a first electronic image of a document;  
second means for providing a second electronic image of a document,  
said second electronic image being a scanned copy of a printed version of  
said first electronic image; and  
third means for comparing said first and second electronic images and  
providing an output in response thereto, *wherein said output signifies  
whether said printed version of said first electronic image is a successful  
print and causes a prohibition of additional printed versions from being  
produced if said output is signified to be a successful print.*

(Emphasis added).

Applicants respectfully submit that independent claim 1 is allowable for at least the reason that *Moscato* in view of *Manchala* does not disclose, teach, or suggest at least "wherein said output signifies whether said printed version of said first electronic image is a successful print and causes a prohibition of additional printed versions from being produced

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if said output is signified to be a successful print," as recited and emphasized above in claim

1.

The Office Action acknowledges that *Moscato* "fails to teach and/or suggest a prohibition of additional printed version from being produced if said output is signified to be a successful print." Office Action, page 2. In making the rejection, the Office Action alleges that *Manchala* "teaches a prohibition of additional printed version from being produced if said output is signified to be a successful print (reprinting is prohibited if the first printed check is successful printed, col. 2, lines 30 to col. 3, lines 35 and col. 5, lines 1-10)." Office Action, pages 2-3. Applicants have reviewed the *Manchala* reference and disagree with the Office Action for at least the following reasons.

*Manchala* appears to teach at most a system for ensuring that a defective check is destroyed before a new check is printed. See col. 1, lines 50-53. When a print operation commences for printing a new check, a "no-print flag" is enabled. See col. 5, lines 3-5. While this flag is enabled, another copy of the check may not be printed. To disable the "no-print flag," one of the following events must occur: (1) a shredder disables the no-print flag in the process of shredding the printed check, col. 3, lines 1-6; or (2) the "proper authorities" disable the no-print flag using a client application or the control panel of the printer. Col. 3, lines 19-47.

*Manchala* does not appear to teach or suggest that an output, in response to comparing first and second electronic images, signifies whether a printed version of the first electronic image is a successful print and causes a prohibition of additional printed versions from being produced. Rather, *Manchala* seemingly prohibits the subject of any print job from having additional prints made, regardless if the print job resulted in a print jam, a clean copy, a bad copy resulting from low toner, etc. Therefore, to enable further copies to be made, either the previous version has to be shredded using a shredding device or the "proper authorities" have to override and reset a "no-print flag."

Thus, *Moscato* in view of *Manchala* fails to teach or suggest "wherein said output signifies whether said printed version of said first electronic image is a successful print and causes a prohibition of additional printed versions from being produced if said output is signified to be a successful print." (Emphasis added). As a result, a *prima facie* case establishing an obviousness rejection by the proposed combination of *Moscato* in view of *Manchala* has not been made.

The rejection should be withdrawn for at least this reason alone.

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b. Claims 2-20

Because independent claim 1 is allowable over the cited art of record, dependent claims 2-20 (which depend from independent claim 1) are allowable as a matter of law for at least the reason that dependent claims 2-20 contain all the elements and features of independent claim 1 and the *Schwenk* reference does not cure the deficiencies of the *Moscato* and *Manchala* references. For at least this reason, the rejections of claims 2-20 should be withdrawn.

Additionally and notwithstanding the foregoing reasons for the allowability of claims 2-20, these dependent claims recite further features/steps and/or combinations of features/steps (as is apparent by examination of the claims themselves) that are patentably distinct from the cited art of record. Hence, there are other reasons why these dependent claims are allowable.

Further, the rejections for claims 7-9 mention a "Bolle" reference that is not one of the references of the proposed combination of references used in making the rejection of the claims. The feature attributed to "Bolle" is believed to be allegedly disclosed by *Schwenk*, although proper support is not provided. Accordingly, Applicants respectfully request the finality of the Office Action be withdrawn, since a proper rejection has not been provided for these claims.

Regarding the *Schwenk* reference, Applicants believe that the reference (and the other references of the proposed combination) fails to teach or suggest the feature, among others, of providing a fingerprint output signal, as described in the claims 8-9.

The rejections should be withdrawn for at least these reasons.

c. Claim 21

As provided in independent claim 21, Applicants claim:

A system for verifying a printed document comprising:  
a computer for providing a first electronic image of a document;  
a printer coupled to said computer;  
a scanner adapted to scan a document printed by said printer to provide a second electronic image of said document, said second electronic image being a scanned copy of a printed version of said first electronic image; and  
software for comparing said first and second electronic images and providing an output in response thereto, *wherein said output signifies whether said printed version of said first electronic image is a successful print and causes a prohibition of additional printed versions from being produced if said output is signified to be a successful print.*

(Emphasis added).

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Applicants respectfully submit that independent claim 21 is allowable for at least the reason that *Moscato* in view of *Manchala* does not disclose, teach, or suggest at least "wherein said output signifies whether said printed version of said first electronic image is a successful print and causes a prohibition of additional printed versions from being produced if said output is signified to be a successful print," as recited and emphasized above in claim 21.

The Office Action acknowledges that *Moscato* "fails to teach and/or suggest a prohibition of additional printed version from being produced if said output is signified to be a successful print." Office Action, page 5. In making the rejection, the Office Action alleges that *Manchala* "teaches a prohibition of additional printed version from being produced if said output is signified to be a successful print (reprinting is prohibited if the first printed check is successful printed, col. 2, lines 30 to col. 3, lines 35 and col. 5, lines 1-10)." Office Action, page 5. Applicants have reviewed the *Manchala* reference and disagree with the Office Action for at least the following reasons.

*Manchala* appears to teach at most a system for ensuring that a defective check is destroyed before a new check is printed. See col. 1, lines 50-53. When a print operation commences for printing a new check, a "no-print flag" is enabled. See col. 5, lines 3-5. While this flag is enabled, another copy of the check may not be printed. To disable the "no-print flag," one of the following events must occur: (1) a shredder disables the no-print flag in the process of shredding the printed check, col. 3, lines 1-6; or (2) the "proper authorities" disable the no-print flag using a client application or the control panel of the printer. Col. 3, lines 19-47.

*Manchala* does not teach or suggest that an output, in response to comparing first and second electronic images, signifies whether a printed version of the first electronic image is a successful print and causes a prohibition of additional printed versions from being produced. Rather, *Manchala* seemingly prohibits the subject of any print job from having additional prints made, regardless if the print job resulted in a print jam, a clean copy, a bad copy resulting from low toner, etc. Therefore, to enable further copies to be made, either the previous version has to be shredded using a shredding device or the "proper authorities" have to override and reset a "no-print flag."

Thus, *Moscato* in view of *Manchala* fails to teach or suggest "wherein said output signifies whether said printed version of said first electronic image is a successful print and causes a prohibition of additional printed versions from being produced if said output is

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signified to be a successful print." (Emphasis added). As a result, a *prima facie* case establishing an obviousness rejection by the proposed combination of *Moscato* in view of *Manchala* has not been made.

The rejection should be withdrawn for at least this reason alone.

d. Claims 22-34

Because independent claim 21 is allowable over the cited art of record, dependent claims 22-34 (which depend from independent claim 21) are allowable as a matter of law for at least the reason that dependent claims 22-34 contain all the elements and features of independent claim 21 and the *Schwenk* reference does not cure the deficiencies of the *Moscato* and *Manchala* references. For at least this reason, the rejections of claims 23-34 should be withdrawn.

Additionally and notwithstanding the foregoing reasons for the allowability of claims 22-34, these dependent claims recite further features/steps and/or combinations of features/steps (as is apparent by examination of the claims themselves) that are patentably distinct from the cited art of record. Hence, there are other reasons why these dependent claims are allowable.

Further, the rejections for claims 23-25 mention a "Bolle" reference that is not one of the references of the proposed combination of references used in making the rejection of the claims. The feature attributed to "Bolle" is believed to be allegedly disclosed by *Schwenk*, although proper support is not provided. Accordingly, Applicants respectfully request the finality of the Office Action be withdrawn, since a proper rejection has not been provided for these claims.

Regarding the *Schwenk* reference, Applicants believe that the reference (and the other references of the proposed combination) fails to teach or suggest the feature, among others, of providing a fingerprint output signal, as described in the claims 24-25.

The rejections should be withdrawn for at least these reasons.

e. Claim 35

As provided in independent claim 35, Applicants claim:

A method for verifying a document including the steps of:  
providing a first electronic image of a document;  
providing a second electronic image of a document, said second electronic image being a scanned copy of a printed version of said first electronic image; and  
comparing said first and second electronic images and providing an output in response thereto, *wherein said output signifies*

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*whether said printed version of said first electronic image is a successful print and causes a prohibition of additional printed versions from being produced if said output is signified to be a successful print.*

(Emphasis added).

Applicants respectfully submit that independent claim 35 is allowable for at least the reason that *Moscato* in view of *Manchala* does not disclose, teach, or suggest at least "wherein said output signifies whether said printed version of said first electronic image is a successful print and causes a prohibition of additional printed versions from being produced if said output is signified to be a successful print," as recited and emphasized above in claim 35.

The Office Action acknowledges that *Moscato* "fails to teach and/or suggest a prohibition of additional printed version from being produced if said output is signified to be a successful print." Office Action, page 2, 7. In making the rejection, the Office Action alleges that *Manchala* "teaches a prohibition of additional printed version from being produced if said output is signified to be a successful print (reprinting is prohibited if the first printed check is successful printed, col. 2, lines 30 to col. 3, lines 35 and col. 5, lines 1-10)." Office Action, page 3, 7. Applicants have reviewed the *Manchala* reference and disagree with the Office Action for at least the following reasons.

*Manchala* appears to teach at most a system for ensuring that a defective check is destroyed before a new check is printed. See col. 1, lines 50-53. When a print operation commences for printing a new check, a "no-print flag" is enabled. See col. 5, lines 3-5. While this flag is enabled, another copy of the check may not be printed. To disable the "no-print flag," one of the following events must occur: (1) a shredder disables the no-print flag in the process of shredding the printed check, col. 3, lines 1-6; or (2) the "proper authorities" disable the no-print flag using a client application or the control panel of the printer. Col. 3, lines 19-47.

*Manchala* does not teach or suggest that an output, in response to comparing first and second electronic images, signifies whether a printed version of the first electronic image is a successful print and causes a prohibition of additional printed versions from being produced. Rather, *Manchala* seemingly prohibits the subject of any print job from having additional prints made, regardless if the print job resulted in a print jam, a clean copy, a bad copy resulting from low toner, etc. Therefore, to enable further copies to be made, either the

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previous version has to be shredded using a special shredding device or the "proper authorities" have to override and reset a "no-print flag."

Thus, *Moscato* in view of *Manchala* fails to teach or suggest "wherein said output signifies whether said printed version of said first electronic image is a successful print and causes a prohibition of additional printed versions from being produced if said output is signified to be a successful print." (Emphasis added). As a result, a *prima facie* case establishing an obviousness rejection by the proposed combination of *Moscato* in view of *Manchala* has not been made.

The rejection should be withdrawn for at least this reason alone.

### CONCLUSION

For at least the reasons set forth above, Applicants respectfully submit that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned agent at (770) 933-9500.

Respectfully submitted,

  
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